The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 51

By: Trial Section Merits Panel
Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Tel: 703-308-9797
Fax: 703-305-0942

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Carol A. Spiegel)

ALICE M. **WANG**, MICHAEL E. DOYLE
and DAVID F. MARK

Junior Party,
U.S. Patent 5,219,727
U.S. Patent 5,476,774

v.

GEORGE **MURAKAWA**, R. BRUCE WALLACE,
JOHN A. ZAIA and JOHN J. ROSSI

Senior Party,
Application 07/402,450

Patent Interference No. 105,055

Before: SCHAFER, TORCZON and SPIEGEL, Administrative Patent Judges.

SPIEGEL, Administrative Patent Judge.

FINAL JUDGMENT

This interference was declared because an interference-in-fact was thought to

exist between all the pending claims in Murakawa's application, i.e., Murakawa claims 34-35, 38-39, 42-44 and 46-47, and various claims of the Wang patents (Paper 1). All of Murakawa's claims were held to be barred under 35 U.S.C. § 135(b) by the 1993 Wang U.S. Patent 5,219,727 (Paper 36). Murakawa was given the opportunity to cure its § 135(b) problem by filing a motion to add one (1) claim that interferes with the claimed subject matter of Wang patents 5,219,727 and 5,476,774 and is not time barred by § 135(b) (Paper 37). Murakawa filed Murakawa Preliminary Motion 1 (Paper 38) to add proposed claim 50. We have denied this motion (Paper 47). Thus, the only pending claims in Murakawa's involved application, i.e., Murakawa claims 34-35, 38-39, 42-44 and 46-47, are unpatentable under § 135(b)(1). Section 135(b) was enacted to be "a statute of repose . . . a statute of limitations, so to speak, on interferences so that the patentee might be more secure in his property right." Corbett v. Chisholm, 568 F.2d 759, 765, 196 USPQ 337, 342 (CCPA 1977). See also, In re McGrew, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) (Noting that § 135(b) acts as a statute of limitation or repose); Berman v. Housey, 291 F.3d 1345, 1348, 63 USPQ2d 1023, 1027 (Fed. Cir. 2002) ("Both the plain language of that provision and the relevant legislative history make clear that it [§ 135(b)] was intended to be a statute of repose, limiting the time during which an interference may be declared 'so that the patentee might be more secure in his property right'", citing Corbett, 568 F.2d at 765, 196 USPQ at 342.) Continuation of this interference under the circumstances of this case would be contrary to the purpose of § 135(b) to act as a statute of limitation or repose. We, therefore, enter judgment against Murakawa.

Termination of the interference at this point without an ORDER TO SHOW CAUSE ("O.C.") is consistent with securing "the just, speedy, and inexpensive determination" of the interference by avoiding needlessly subjecting the parties to redundant and unnecessary expenditures of time, effort and money. 37 CFR § 1.601. The threshold § 135(b) issue has been fairly presented and fully briefed and decided by a three judge panel. Murakawa has been provided the opportunity to cure its § 135(b) problem. Murakawa Preliminary Motion 1 has also been fairly present, fully briefed and decided by a three judge panel. Hence, an O.C. would provide on process or relief that has not already been provided. Finally, attention is directed to 37 CFR § 1.658(b).

Accordingly, it is

ORDERED that judgment on priority as to Counts 1 and 2 (Paper 1, p. 5) is awarded against senior party GEORGE J. MURAKAWA, R. BRUCE WALLACE, JOHN A. ZAIA and JOHN J. ROSSI.

FURTHER ORDERED that senior party GEORGE J. MURAKAWA, R. BRUCE WALLACE, JOHN A. ZAIA and JOHN J. ROSSI is not entitled to a patent containing

(i) claims 34-35, 38-39, 42-44 and 46-47 (corresponding to Count 1), and

(ii) claim 45 (corresponding to Count 2)

of application 07/402,450, filed September 1, 1989.

FURTHER ORDERED that a copy of this paper shall be made of record in the files of U.S. Patents 5,219,727 and 5,476,774 and of application 07/402,450.

FURTHER ORDERED that a copy of the decisions on motions filed November 5,

2003 (Paper 36) and April 5, 2004 (Paper 47) shall be made of record in the files of U.S. Patents 5,219,727 and 5,476,774 and of application 07/402,450.

FURTHER ORDERED that if there is a settlement agreement which has not been filed, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

RICHARD E. SCHAFER
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

CAROL A. SPIEGEL
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

cc (via electronic mail):

Wang (real party-in-interest
ROCHE MOLECULAR SYSTEMS, INC.):

R. Danny Huntington, Esq.
Malcolm K. McGowan, Esq.
BURNS, DOANE, SWECKER & MATHIS, LLP
1737 King St., Suite 500
Alexandria, VA 22314
Tel: 703-836-6620
Fax: 703-836-2021
E-mail: dannyh@burnsdoane.com
malcolmm@burnsdoane.com

Murakawa (real party-in-interest
CITY OF HOPE and
BECTON DICKINSON COMPANY):

E. Anthony Figg, Esq.
Jeffrey Ihnen, Esq.
ROTHWELL FIGG ERNST & MANBECK, PC
1425 K. Street, N.W., Suite 800
Washington, DC 20005
Tel: 202-783-6040
Fax: 202-783-6031
E-mail: evanlee@rothwellfigg.com